



UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

OCT 20 2002

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
1300 I STREET, N.W.
WASHINGTON, DC 20005-3315

#17

In re Application of Jacques Mallet et al. :
Serial No.: 09/578,453 :
Filed: May 26, 2000 : PETITION DECISION
Attorney Docket No.: PF-0417-2 DIV :

This is in response to applicants' petition, filed August 9, 2002 under 37 CFR 1.144, requesting withdrawal of the restriction requirement set forth by the examiner.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111(b) on May 26, 2000 as a continuation of application 08/624,469, filed May 10, 1996, which was the national stage of PCT/FR94/01142, filed September 29, 1994. Applicants filed a preliminary amendment canceling claims 1-15 and replacing them with claims 16-31. On October 2, 2001, the examiner mailed a restriction requirement dividing the claims into 6 groups, as follows:

- I. Claims 16-22, 25 and 26, drawn to a recombinant virus comprising a nucleic acid encoding a mutated p53 protein and its use in a method of inhibiting toxicity in cultured cells.
- II. Claims 16-20, 22, 25 and 26, drawn to a recombinant virus comprising a nucleic acid comprising a p53 binding site and its use in a method of inhibiting toxicity in cultured cells.
- III. Claims 16-26, drawn to a recombinant virus comprising a nucleic acid encoding an antisense RNA which inhibits expression of p53 and its use in a method of inhibiting toxicity in cultured cells.
- IV. Claims 27-31, drawn to a method for identifying compounds which inhibit p53 activity.

In the response filed October 18, 2001, applicants elected Group I. Applicants traversed the restriction requirement, arguing that groups I-III should be rejoined.

On January 2, 2002 the examiner (a different examiner) mailed a first action on the merits. A supplemental Office action was mailed on April 11, 2002. In both actions, the examiner made

the restriction final. On August 9, 2002 applicants filed a response to the outstanding Office action and the petition now under consideration.

DISCUSSION

In the petition, applicants present several lines of argument for their position that groups I-III should be rejoined.

Inspection of the prosecution history of the parent application, 08/624,469, reveals that groups I-III were examined together (by a third examiner) and all claims were either rejected over prior art or found allowable. In view of this fact, it would not be a burden for the present examiner to examine all three groups.

DECISION

Applicants's petition is **GRANTED** for the reasons set forth above.

The application will be forwarded to the examiner for consideration of claims 16-26 in their entirety, in light of applicants' response filed August 9, 2002, following mailing of this decision.

Since no fee is required for this petition, **the petition fee paid of \$130 will be credited to Deposit Account No. 06-0916, as directed.**

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-4205 or by facsimile transmission at (703) 746-5006.

John Doll
Director, Technology Center 1600

